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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zuffa, LLC

Serial No. 76/273,529

Parker H. Bagley of Milbank, Tweed, Hadley & McCoy for
Zuffa LLC.

Lauriel Dalier, Trademark Examining Attorney, Law Office
116 (Meryl Hershkowitz, Managing Attorney).

Before Cissel, Hanak and Holtzman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 18, 2001, applicant filed the above-identified
application to register the mark ULTIMATE FIGHTING
CHAMPIONSHIP on the Principal Register for a long list of
products in Class 28. The stated basis for filing the
application was applicant's claim that it had used the mark
in commerce in connection with these goods since May of
2001.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), based on the assertion that applicant's mark is likely to cause confusion with two cited registered marks. Registration was also refused under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that applicant's mark is merely descriptive of the goods listed in the application. The Examining Attorney also raised other informalities, including a requirement for amendment to the identification-of-goods clause, a requirement for substitute specimens and a requirement under Trademark Rule 2.61(b) for applicant to submit samples of advertisements or promotional materials for its products in order to allow the Examining Attorney to understand better the nature of applicant's products.

In support of the refusal to register based on descriptiveness, the Examining Attorney submitted copies of excerpted articles she retrieved from a database of publications. These articles show the term "ultimate fighting" used to refer to a type of athletic competition. Examples include the following:

"With the opening of an ultimate fighting school for adults in Micky's Gym Boxing Club for kids, which teaches boxing only, Burnett is doing fewer ultimate flights, he said." The Tulsa World, Sept. 26, 2001.

"Warren runs his own martial arts dojo, teaching 'shoot fighting,' a style used in no-holds-barred fighting, such as ultimate fighting." The Press-Enterprise, Riverside, California, Sept. 13, 2001.

"The Los Angeles company reps talent in mixed martial arts, a sport second only to soccer in popularity around the world. Similar to ultimate fighting, the sport combines all the skill sets of the various martial arts disciplines—wrestling, boxing, judo and karate—into one event." Daily Variety, Aug. 10, 2001.

"Modesitt said that had been a problem in Wheeling, where promoters referred to the events alternatively as extreme or ultimate fighting, or as mixed martial arts." The Charleston Gazette, June 2, 2001.

"While West Virginia's athletic commission still won't sanction ultimate fighting matches, fans of the mixed martial arts can view matches through cable television and increasingly on the Internet." Charleston Daily Mail, April 9, 2001.

Additionally, the Examining Attorney included a dictionary definition of the word "championship" as "a competition or series of competitions held to determine a winner."

Applicant responded with argument that the refusals to register were not well taken. Applicant claimed ownership of the two registrations the Examining Attorney had cited as bars to registration under Section 2(d) of the Act. With regard to the refusal based on mere descriptiveness, applicant contended that "not every person in the United States would perceive the term 'ultimate fighting' as boxing or martial arts sports fighting. In fact, there is

no dictionary definition at all for 'ultimate fighting'... a quick Internet search for the term 'ultimate fighting' revealed multiple other uses for the term besides martial arts sports fighting..."

The identification-of-goods clause in the application was amended to read as follows:

"rubber balls; action figures and accessories therefore; action skill games; bean bag dolls; plush toys; balloons; golf balls; tennis balls; bath toys; Christmas tree ornaments; board games; building blocks; equipment sold as a unit for playing card games; dolls and doll clothing; doll playsets; children's play cosmetics; crib toys; electric action toys; manipulative games; golf gloves; golf ball markers; jigsaw puzzles; kites; mobiles; music box toys; party favors in the nature of small toys; inflatable pool toys; multiple activity toys; wind-up toys; target games; disk-type toss toys; bows and arrows; toy vehicles; toy cars; toy trucks; toy bucket and shovel sets; roller skates; toy model hobbycraft kits; toy rockets; toy guns; toy holsters; musical toys; badminton sets; bubble making wands and solution sets; toy figurines; toy banks; puppets; yo-yos; skateboards; scooters; face masks; hand-held electronic games," in Class 28.

Additionally, applicant submitted substitute specimens, along with a declaration attesting to their use in commerce prior to the filing date of the application. The substitute specimens appear to be copies of pages from applicant's website. The mark is shown above photographs of individual combatants, beneath which the words "REAL FIGHTERS, REAL FIGHTING" are shown. Four trademarks for video games such as PLAYSTATION and XBOX are listed along the left side of the first such page. On another page, the

mark is shown along with the registered mark PLAYSTATION, under which "game features" is shown. The last page begins with this sentence: "The PlayStation gets its first taste of realistic fighting with Ultimate Fighting Championship." The text goes on to list in detail the features offered in this game.

The Examining Attorney withdrew the refusal to register based on likelihood of confusion, but maintained and made final the refusal to register under Section 2(e)(1) of the Act based on descriptiveness. Additional excerpts from printed publications were submitted in support of this refusal. Examples include the following:

"He yearned for the athletic competition of his high school days and saw ultimate fighting, a sport that mixes martial arts, wrestling and kick-boxing, as a way of getting back to that." The Los Angeles Times, April 19, 2002.

"... after dozens of Mongols biker gang members were enraged by the outcome of an ultimate fighting competition, which meshes boxing and martial arts." The Las Vegas Review-Journal, April 30, 2002.

"An initial ordinance banning ultimate fighting, a similar but more controversial mixed martial-arts sport, failed on a 4-3 voted in November." Saint Paul Pioneer Press, Jan. 30, 2002.

The Examining Attorney noted that the goods in the amended application include hand-held electronic games, and concluded that the mark describes a feature or

characteristic of them, that they simulate ultimate fighting championships.

Additionally, the Examining Attorney made final the requirement for a specimen which shows the mark used in commerce in connection with at least one of the products listed in the application, as amended. She contended that the substitute specimens do not show the use of the mark for any of the products identified therein. She also made final the requirement under Rule 2.61(b) for applicant to submit additional information about its products sold under the mark.

Applicant timely filed a Notice of Appeal and a request for reconsideration, arguing that the "[a]pplication of the mark ULTIMATE FIGHTING TOURNAMENT (sic) to a variety of toys and games provides no information concerning these specific products, and is therefore not descriptive of these goods. At worst, the mark suggests that the nature of the items which are derived from Applicant's services may be thematic. Similarly, while the mark may suggest that Applicant's services relate to some type of competition, it gives no indication of the highly specialized martial arts competitions which Applicant arranges and produces."

Applicant argued that its mark has been registered for goods in other classes and that it is a well-known mark. Attached as support for this contention was a copy of a final judgment and permanent injunction (on consent) in connection with a civil action against Ultimate Athlete Fighting, Inc. which is dated January 23, 2002.

Additionally, applicant submitted excerpts from published articles wherein the term sought to be registered is shown with initial capital letters, which applicant argued is a clear reference to itself, rather than descriptive use of the words. These examples are varied, however. For example, the Riverside, California, Press-Enterprise article from March 23, 2002 states that

"First of all, events of this type are known as mixed martial arts; not 'no-holds-barred' or 'Ultimate Fighting.' The Ultimate Fighting Championship, UFC, is a specific company that holds mixed martial arts, MMA, events; the event held that Casino Morongo has no affiliation with the UFC. The Ultimate Fighting Championship, along with many other organizations, has been working hard to improve the reputation of this new sport, but articles like these only hurt that effort...

The excerpt from the April 20, 2002 edition of The Plymouth Evening Herald is less than a clear reference to applicant, however. It simply states that "[t]he Ultimate Fighting Championship brings together fighters from all disciplines of martial arts."

Applicant also submitted advertisements for its entertainment services rendered on pay-per-view television, and a history of events sponsored by applicant as part of its "Ultimate Fighting Championship" competitions. Also submitted was an article from applicant's website describing the success of applicant's events.

With respect to the final requirement for additional specimens, applicant stated that the specimen submitted responsive to the first Office Action is a photo of an actual package containing applicant's action skill game, and that therefore the specimen demonstrates the use of the mark in commerce in connection with one of the items listed in the application, as amended.

The request for reconsideration did not address the requirement made by the Examining Attorney under Rule 2.61(b) for additional information about applicant's goods.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for reconsideration in accordance with applicant's request.

Upon reconsideration, the Examining Attorney maintained the final refusal to register under Section 2(e)(1) of the Act and the final requirement for acceptable specimens of use. Although she did not specifically

mention the requirement for additional product information which had been made final in the second Office Action, she adhered "to the final action as written." Applicant's request for reconsideration had not addressed that requirement. The Examining Attorney noted that her review of the application file did not result in discovery of a specimen that looked like packaging for applicant's games, and she concluded that the substitute specimens applicant had submitted appeared to be "either copies of website pages advertising the goods and other services and/or advertisements for the goods wherein a computer game or hand-held game appeared without any mark imprinted thereon (or at least not visible to the examiner)."

In view of the Examining Attorney's response to applicant's request for reconsideration, the Board resumed action on the appeal. Applicant filed an appeal brief, the Examining Attorney filed her brief on appeal and applicant filed a reply brief. Applicant, however, did not request an oral hearing before the Board.

Based on careful consideration of the record and arguments before us in this appeal, we find that the requirement for additional specimens is not well taken, but that the requirement for additional product information is proper, and that, in any event, the refusal to register

under Section 2(e)(1) of the Lanham Act is supported by this record.

Turning first to the requirement for submission of additional specimens, we note that Trademark Rule 2.56 requires that an application based on use of the mark in commerce must be supported by a "specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce." As noted above, the Examining Attorney views the specimens submitted responsive to the first Office Action as simply advertisements for applicant's games, rather than as evidence of the use of the mark on packaging for them.

Simply put, while the specimens submitted by applicant do appear to have come from applicant's website, this is not inconsistent with applicant's statement that the specimen shows a copy of a photograph of the packaging for applicant's game. That a photograph of applicant's packaging bearing the mark sought to be registered appears on applicant's website does not somehow make such a photograph less than it is. This photograph appears to be of the front of a box for one of applicant's games. Applicant has stated that it is. The box shows the mark sought to be registered used to identify the source of the game which would be contained within the package. As noted

above, applicant provided a declaration stating that the specimen was in use prior to the filing of the application. This satisfies the requirements of Trademark Rule 2.56, so the requirement for an additional specimen is not well taken.

Regarding the requirement for product information, as we noted above, this requirement was appropriately made in the first Office Action, but applicant did not respond to it. The requirement was made final in the second Office Action, but again applicant ignored the requirement. Neither applicant's appeal nor the request for reconsideration mentions this requirement. The attachments to the latter do not appear to relate to the goods listed in the instant application, nor does applicant even attempt to explain how they might do so.

Trademark Rule 2.61(b) states that the Examining Attorney may require an applicant "to furnish such information and exhibits as to be reasonably necessary to the proper examination of the application." In view of the fact that applicant has ignored this reasonable request and has not even argued that it is unwarranted, we affirm the requirement.

We thus turn to the refusal to register based on descriptiveness under Section 2(e)(1) of the Lanham Act.

The test for determining whether a mark is merely descriptive under this section of the Act is well settled. A mark is merely descriptive of the goods in question if it immediately and forthwith conveys information concerning a significant quality, characteristic, feature, function, purpose or use of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions or features of the goods in order for it to be considered merely descriptive of them; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which it is being used in connection with those goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). The mark is suggestive, rather than merely descriptive, if, when the goods are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what

attributes of the goods the mark indicates. In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984). As we have stated previously, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992, and In re TMS Corp. of the Americas, 200 USPQ 57 (TTAB 1978).

We agree with the Examining Attorney that the record in this application shows that the term "ultimate fighting" is used to describe a type of athletic competition which combines several forms of the martial arts. While there can be no dispute but that applicant uses the term as part of its trade name and also in the manner of a trademark on its products, such use does not somehow convert the widespread descriptive use of the term by others into the intellectual property of applicant.

When the descriptive terminology "ultimate fighting" is combined with the equally descriptive word "championship," the resulting combination is also merely descriptive of an ultimate fighting competition. No complex reasoning or multi-step thought processes are required in order to take this meaning from the mark. In

that such a competition appears to be the central feature or characteristic of applicant's hand-held electronic games, the term sought to be registered, ULTIMATE FIGHTING CHAMPIONSHIP, is merely descriptive of these goods within the context of Section 2(e)(1) of the Lanham Act.

Applicant's arguments to the contrary are not persuasive. That "not every person in the United States would perceive the term 'ultimate fighting' as boxing or martial arts sports fighting" is not determinative of the issue. Implicit in this statement made by applicant in response to the first Office Action is the notion that some people do understand what ultimate fighting is. This is consistent with the evidence made of record by the Examining Attorney showing descriptive use of the term by others in connection with this sport. In order for the mark to fall within the proscription of Section 2(e)(1) of the Act, the descriptive significance of the mark does not have to be apparent to everyone. It is sufficient if a significant portion of prospective purchasers of applicant's products understand that "ultimate fighting" is used to identify the sport of mixed martial arts fighting, and that the word "championship" identifies a competition or series of competitions held in order to determine a winner. The descriptive significance of the mark with

respect to applicant's games, which feature or are about ultimate fighting championships, would be apparent to such people.

Similarly, that the combination of descriptive terms applicant seeks to register is not listed in a dictionary does not mandate reversal of the refusal to register in this case. The combination of the ordinary meanings of the terms which combine to make up this mark results in a term which merely describes a significant characteristic of the hand-held games listed in the application, namely that they feature or are based on ultimate fighting championships.

We note further that in its appeal brief, applicant requested that if the Board were to determine that its mark cannot be registered on the Principal Register because it is merely descriptive of the goods listed the application, amendment to the Supplemental Register should be permitted. The Examining Attorney, in her brief on appeal, stated that she would approve this mark for registration on the Supplemental Register if an acceptable specimen of use were submitted.

Applicant's alternative amendment cannot be allowed at this juncture, however. Prior to submission of its appeal brief, applicant never raised registration on the Supplemental Register as an alternative, so this issue was

not before the Board on appeal. Trademark Rule 2.142(g) states that "an application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under Section 6 of the Act of 1946 or upon order of the Commissioner." Accordingly, notwithstanding the apparent willingness of the Examining Attorney to accommodate applicant, applicant's request cannot be granted.

DECISION: Although the requirement for a substitute specimen is reversed, both the requirement under Rule 2.61(b) for submission of additional information regarding the goods listed in the application and the refusal to register under Section 2(e)(1) of the Act are affirmed.